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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/753,678	01/04/2001	Norman G. Anderson	41333	2803
7590	06/07/2004			
			EXAMINER	
			TABATABAI, ABOLFAZL	
		ART UNIT	PAPER NUMBER	
		2625		
DATE MAILED: 06/07/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/753,678	ANDERSON ET AL.
Examiner	Art Unit	
Abolfazl Tabatabai	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 02 April 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 48-51 and 71-76 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 48-51 and 71-76 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 04 January 2001 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date: _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
Paper No(s)/Mail Date <u>4/5/8</u> .	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

### **Claim Rejections - 35 USC § 102**

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 48 and 49 are rejected under 35 U.S.C. 102(e) as being anticipated by Johnson et al (U S 6,581,011 B1).

Regarding claim 48, Johnson discloses a method for processing data in database contained in a storage medium, comprising the steps of:

(a) storing in the database data that includes at least one pattern, the data based upon a statistically significant number of samples, the data including at least one parameter of each sample (column 7, lines 56-62);

(b) comparing unknown data with a data stored in the database (column 21, lines 23-42); and,

(c) recording differences and similarities (column 20, lines 2-5).

Regarding claim 49, Johnson discloses a method wherein the at least one pattern represents proteins or polypeptides (column 14, lines 33-40).

## Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 50, 51 and 71-76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al (U S 6,581,011 B1) in view of Palmer et al (U S 6,146,863).

Regarding claim 50, Johnson is silent about the specific details regarding the step of the parameters is one selected from the group consisting of molecular weight and isoelectric point.

In the same field "polynucleotides and polypeptides identification and their production" endeavor, however, Palmer discloses staphylococcus 3-hcd polypeptides and

polynucleotides comprising the step of the parameters is one selected from the group consisting of molecular weight and isoelectric point (column 6, lines 13-18).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use molecular weight and isoelectric point as taught by Palmer in the system of Johnson because Palmer provides Johnson a method for using such polynucleotides and polypeptides, including treatment of microbial diseases, among others. This method is being useful to screen compounds for antimicrobial activity. Such factors are also useful to determine their role in pathogenesis of infection, dysfunction and diseases.

Regarding claim 51, Johnson is silent about the specific details regarding the step of parameter is data output from a mass spectrometry analysis. In the same field "polynucleotides and polypeptides identification and their production" endeavor, however, Palmer discloses staphylococcus 3-hcd polypeptides and polynucleotides comprising the step of the parameter is data output from a mass spectrometry analysis (column 14, line 21).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use a mass spectrometry analysis as taught by Palmer in the system of Johnson because Palmer provides Johnson a method for using such polynucleotides and polypeptides, including treatment of microbial diseases, among others. This method is being useful to screen compounds for antimicrobial activity. Such factors are also useful to determine their role in pathogenesis of infection, dysfunction and diseases.

Regarding claim 71, Johnson is silent about the specific details regarding the step of the samples are selected from one of the group consisting of serum, organ, tissues, cells, organelles and fractions.

In the same field "polynucleotides and polypeptides identification and their production" endeavor, however, Palmer discloses staphylococcus 3-hcd polypeptides and polynucleotides comprising the step of samples are selected from one of the group consisting of serum, organ, tissues, cells, organelles and fractions (column 25, lines 20-26 and column 36, lines 24-26).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use cells, tissues and fractions as taught by Palmer in the system of Johnson because Palmer provides Johnson a method for using such polynucleotides and polypeptides, including treatment of microbial diseases, among others. This method is being useful to screen compounds for antimicrobial activity. Such factors are also useful to determine their role in pathogenesis of infection, dysfunction and diseases.

Regarding claim 72, Johnson is silent about the specific details regarding the step of the differences and similarities in the database indicate one of the following states: aging, disease, and presence of a toxin and presence of a pathogen.

In the same field "polynucleotides and polypeptides identification and their production" endeavor, however, Palmer discloses staphylococcus 3-hcd polypeptides and polynucleotides comprising the step of the differences and similarities in the database

indicate one of the following states: aging, disease, and presence of a toxin and presence of a pathogen (column 11, lines 48-55 and column 9, lines 55-57). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use the differences and similarities in the database indicate one of the following states: aging, disease, presence of a toxin and presence of a pathogen as taught by Palmer in the system of Johnson because Palmer provides Johnson a method for using such polynucleotides and polypeptides, including treatment of microbial diseases, among others. This method is being useful to screen compounds for antimicrobial activity. Such factors are also useful to determine their role in pathogenesis of infection, dysfunction and diseases.

Claim 73 is similarly analyzed as claim 72 above.

Regarding claim 74, Johnson discloses the method further comprising the step of:

classifying a state of a sample by the step of:

comparing the pattern in the sample with the stored patterns in the database to identify differences and similarities (column 14, lines 41-46 and column 21, lines 23-42); using the identified differences and similarities to confirm the state thereof (column 7, lines 37-48).

However, Johnson is silent about the specific details regarding the step of detecting a pattern in the sample.

In the same field "polynucleotides and polypeptides identification and their production" endeavor, however, Palmer discloses staphylococcus 3-hcd polypeptides and

polynucleotides comprising the step of detecting a pattern in the sample (column (column 14, lines 23-26).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use the detecting a pattern in the sample as taught by Palmer in the system of Johnson because Palmer provides Johnson a method for using such polynucleotides and polypeptides, including treatment of microbial diseases, among others. This method is being useful to screen compounds for antimicrobial activity. Such factors are also useful to determine their role in pathogenesis of infection, dysfunction and diseases.

Claim 75 is similarly analyzed as claim 73 above.

Regarding claim 76, Johnson is silent about the specific details regarding the step of the pattern is discriminatory pattern.

In the same field "polynucleotides and polypeptides identification and their production" endeavor, however, Palmer discloses staphylococcus 3-hcd polypeptides and polynucleotid comprising the step of the pattern is discriminatory pattern (column 22, lines 40-51).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use the pattern is discriminatory pattern as taught by Palmer in the system of Johnson because Palmer provides Johnson a method for using such polynucleotides and polypeptides, including treatment of microbial diseases, among others. This method is being useful to screen compounds for antimicrobial activity. Such factors are also useful to determine their role in pathogenesis of infection, dysfunction

and diseases.

**Other Prior Art**

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Andrews et al (U S 5,506,117) disclose biomedical process for growing living cells by measuring the amount of nutrient added to the reaction medium.

Bevilacqua et al (U S 6,692,916 B1) disclose method and apparatus for Characterizing a biological condition or agent using precision gene expression profiles.

Paulse et al (U S 6,675,104 B2) disclose method for analyzing mass spectra.

Allen (U S 6,357,285 B1) discloses method and apparatus for the quantitative and objective correlation of data from a local sensitive force detector.

**Contact Information**

6. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to ABOLFAZL TABATABAI whose telephone number is (703) 306-5917.  
The Examiner can normally be reached on Monday through Friday from 9:30 a.m. to 7:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Mehta Bhavesh M, can be reached at (703) 308-5246. The fax phone number for organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published

applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Abolfazl Tabatabai

Patent Examiner

Group Art Unit 2625

May 22, 2004



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